

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Cowley <i>et al.</i>	Art Unit :	1656
Patent No. :	8,058,233	Conf. No. :	6101
Issue Date :	November 15, 2011	Examiner :	Anand U. Desai
Serial No. :	10/501,411		
Filed :	July 12, 2004		
Title :	MODIFICATIONS OF FEEDING BEHAVIOR USING PYY AND GLP-1		

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being electronically filed in accordance with § 1.6(a)(4) on the 13th day of January, 2012.

/Allyson R. Hatton/

Allyson R. Hatton, Ph.D. (Reg. No. 54,154)

Commissioner for Patents

**REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(d)**

Dear Sir:

Patentees request that the Patent Term Adjustment for the above-identified U.S. Patent be reconsidered. It is Patentee's belief that the Patent Term Adjustment on the issued patent (set at 903 days as stated on the Patent cover sheet, which is attached as Exhibit A) is incorrect and that the Patent Term Adjustment for which the above-identified patent is entitled is **819 days**.

As required under 37 CFR § 1.705(d), this request is properly submitted within two months of the patent issue date.

Under 37 CFR § 1.702, the grounds for reconsideration of patent term adjustment include examination delays under the Patent Term Guarantee Act of 1999. The correct patent term adjustment and the bases under § 1.702, and the relevant dates as specified in § 1.703(a) through (e) for which the adjustment is sought, and the adjustment as specified in § 1.703(f) to which the patent is entitled, follows.

Under 37 CFR § 1.702(a) (hereinafter "A Delay"), Patentees are entitled to a period of patent term adjustment which is the period of delay of 392 days due to failure by the U.S. Patent & Trademark Office ("the Office") to mail an action under 35 USC § 132 not later than 14 months after the actual filing date (*i.e.*, by September 7, 2006) (hereinafter "14 month Delay")

(see 37 CFR § 1.702(a)(1)). As the Office failed to mail an action under 35 USC § 132 until October 4, 2007, Patentees are entitled to a period of adjustment beginning on the day after the date that is 14 months after the date on which the above-referenced application was filed under 35 USC § 111(a), *i.e.*, September 8, 2006, and ending on the date of mailing of an action under 35 USC § 132, *i.e.*, October 4, 2007 (see 37 CFR § 1.703(a)(1)). Accordingly, the period of patent term adjustment due to the 14 Month Delay by the Office is 392 days, which is in agreement with the period calculated by the Office (see Patent Term Adjustment History downloaded from PAIR, submitted herewith as Exhibit B; see also Exhibit C, which is a timeline illustrating the periods of Office and Applicant Delay).

Patentees are also entitled to a period of patent term adjustment which is the period of delay of 13 days due to failure by the Office to mail an action under 35 USC § 132 not later than four months after the Applicants filed a Response to Restriction Requirement (*i.e.*, by April 3, 2008) (hereinafter “Four month Delay”) (see 37 CFR § 1.702(a)(2)). As the Office failed to mail an action under 35 USC § 132 until April 16, 2008, Patentees are entitled to a period of adjustment beginning on the day after the date that is four months after the date on which the above-referenced application was filed under 35 USC § 111(a), *i.e.*, April 4, 2008, and ending on the date of mailing of an action under 35 USC § 132, *i.e.*, April 16, 2008 (see 37 CFR § 1.703(a)(2)). Accordingly, the period of patent term adjustment due to this first Four Month Delay by the Office is 13 days, which is in agreement with the period calculated by the Office (see Exhibit B).

Patentees are also entitled to a period of patent term adjustment which is the period of delay of 153 days due to failure by the Office to mail an action under 35 USC § 132 not later than four months after the Applicants filed a Request for Continued Examination and Submission (*i.e.*, by June 12, 2010) (see 37 CFR § 1.702(a)(2)). As the Office failed to mail an action under 35 USC § 132 until November 12, 2010, Patentees are entitled to a period of adjustment beginning on the day after the date that is four months after the date on which the above-referenced application was filed under 35 USC § 111(a), *i.e.*, June 13, 2010, and ending on the date of mailing of an action under 35 USC § 132, *i.e.*, November 12, 2010 (see 37 CFR

§ 1.703(a)(2)). Accordingly, the period of patent term adjustment due to this second Four Month Delay by the Office is 153 days, which is in agreement with the period calculated by the Office (see Exhibit B).

Accordingly, as the Office has concluded, Patentees are entitled to a total period of A delay of 558 days (= 392 days + 13 days + 153 days). This calculation is in agreement with the calculation by the Office (see Exhibit B).

In addition to the patent term adjustment due to A Delay according to 37 CFR § 1.702(a), Patentees respectfully submit that they are also entitled to a period of patent term adjustment under 37 CFR § 1.702(b) due to failure of the Office to issue a patent within three years after the date the corresponding application was filed under 35 USC § 111(a), *i.e.*, by July 12, 2007 (hereinafter “B Delay”). The period of adjustment under 37 CFR § 1.702(b) is the number of days in the period beginning on the date after the date that is three years after the date on which the application was filed under 35 USC § 111(a) (*i.e.*, July 13, 2007) and ending on the date the patent issued, but not including the number of days in the period beginning on the date on which a Notice of Appeal was filed (*i.e.*, July 7, 2009) and ending on the date the patent was issued (see 37 CFR § 1.702(b)(1)). Since the Office failed to issue the above-identified patent until November 15, 2011, which is more than three years after the filing date of the application under 35 USC § 111(a), Patentees are entitled to a period of patent term adjustment beginning on the day after the date that is three years after the filing date of the application, *i.e.*, July 13, 2007, and ending on the date on the date a patent was issued, *i.e.*, November 15, 2011, but not including the sum of the number of days in the following time periods: (i) the number of days beginning on the date on which the RCE was filed, *i.e.*, February 12, 2010, and the date the patent was issued, *i.e.*, November 15, 2011 (37 CFR § 1.703(b)(1), and (ii) the number of days in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 USC § 134 and 37 CFR § 41.34, *i.e.*, July 7, 2009, and ending on the date of mailing of an action under 35 USC § 132, *i.e.*, November 12, 2010, (37 C.F.R. § 1.703(b)(4)).

Since Applicants withdrew the application from appeal by filing a request for Examination after filing the Notice of Appeal, the amount of B delay is decreased by the number of days in the period beginning on the date of filing the notice of appeal, *i.e.*, July 7, 2009, and ending on the date of issue, *i.e.*, November 15, 2011. There are 1587 days in the period beginning on the day after the date that is three years after the filing date of the application, *i.e.*, July 13, 2007, and ending on the date on the date a patent was issued, *i.e.*, November 15, 2011 (37 CFR § 1.702(b)). There are 862 days beginning on the date on which the notice of appeal was filed and ending on the date on the date a patent was issued, *i.e.*, November 15, 2011. Thus, the period of patent term adjustment due to the B Delay by the Office is 725 days (= 1587 days – 862 days). This calculation is in agreement with the calculation by the Office (see Exhibit B).

As set forth in 37 CFR § 1.703(f), Patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR § 1.702 (*i.e.*, Office Delay) reduced by the period of time equal to the period of time during which Patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR § 1.704 (*i.e.*, Applicant Delay). With respect to the above-referenced application, the total period of Office Delay is the sum of the period of A Delay (558 days) and the period of B Delay (725 days) to the extent that such periods of delay are not overlapping. There are two periods of delay overlap: (i) the 84 days between the end of the period of 14 Month Delay, *i.e.*, October 4, 2007, and the beginning of the period of the B Delay, *i.e.*, July 12, 2007; and (ii) the 13 days of the first Four Month Delay (see Exhibit C). Accordingly, Patentees submit that the total days of Office Delay overlapping is 97 days, which is the sum of the 84 days overlap between the 14 month delay and the three year delay, and the 13 days of the first Four Month Delay. Applicants believe that the Office erroneously calculated this period of overlap to be just 13 days (see Exhibit B).

Applicants accordingly submit that the total number days of Office Delay is 1186 days (558 days A Delay + 725 days B delay – 97 days overlap of A and B delay). Applicants believe that the calculation of total days Office delay by the PTO of 1270 days is incorrect (see Exhibit B).

Under 37 CFR § 1.703(f), to calculate the period of patent term adjustment, the total period of Office Delay is reduced by the period of Applicant Delay as specified in 37 CFR § 1.704. The USPTO has calculated the period of Applicant delay to be 367 days (see Exhibit B). Applicants agree with this calculation.

Under 37 CFR § 1.704(b), Applicants agree to have delayed 55 days between the dates of July 17, 2008, and September 9, 2008, which is the period of time beginning on the date after the date that is three months after the date of mailing of a request by the Office (a Non-Final Rejection) and ending on the date of submission of Applicants' Response (see Exhibit B).

Also under 37 CFR § 1.704(b), Applicants agree to have delayed 90 days between the dates of April 9, 2009, and July 7, 2009, which is the period of time beginning on the date after the date that is three months after the date of mailing of a request by the Office (a Final Rejection) and ending on the date of submission of a Notice of Appeal (see Exhibit B).

Also under 37 CFR § 1.704(b), Applicants agree to have delayed 59 days between the dates of February 13, 2011, and April 12, 2011, which is the period of time beginning on the date after the date that is three months after the date of mailing of a request by the Office (a Non-Final Rejection) and ending on the date of submission of Applicants' Response (see Exhibit B).

Also under 37 CFR § 1.704(c)(8), Applicants agree to have delayed 118 days between the dates of February 13, 2010, and June 10, 2010, which is the period of time beginning on the date after the date that an RCE was filed by Applicants, and ending on the date of submission of a the second of two Information Disclosure Statements (see Exhibit B).

Also under 37 CFR § 1.704(c)(8), Applicants agree to have delayed 45 days between the dates of April 13, 2011, and May 27, 2011, which is the period of time beginning on the date after the date that a Response to Non-Final Office Action was filed by Applicants, and ending on the date of submission of an Information Disclosure Statement (see Exhibit B).

Applicant : Cowley *et al.*
Patent No. : 8,058,233
Issued : November 15, 2011
Serial No. : 10/501,411
Filed : July 12, 2004
Page : 6 of 6

Attorney's Docket No.: W2023-7044US / PC070431A

In view of the foregoing, Applicants delayed a total of 367 days (the sum of 55 days + 90 days + 59 days + 118 days + 45 days), which is in agreement with the number of days calculated by the Office (see Exhibit B).

Under 37 CFR § 1.703(f), the period of patent term adjustment is the period of Office Delay reduced by the period of Applicant Delay. Accordingly, Patentees submit that the correct patent term adjustment for the above referenced application is **819 days**, which is the difference between the total period of Office Delay (1186 days) and the period of Applicant Delay (367 days).

In view of the foregoing it is respectfully requested that this Request for Reconsideration of Patent Term Adjustment be favorably considered and that a corrected Determination of Patent term Adjustment be issued to reflect a patent term adjustment of **819 days**.

The above-identified patent is subject to a terminal disclaimer over U.S. Patent No. 7,459,432. There is no expiration date specified in the terminal disclaimer.

Pursuant to 35 USC § 154(b)(4)(A), Patentees reserve the right to file a civil action against the Director in the United States District Court for the District of Columbia should the Director deny the present request for revision of patent term adjustment.

In accordance with 37 CFR § 1.705(b)(1), please charge the fee of \$200 as required under 37 CFR § 1.18(e), and any other necessary charges, or any credits, to Deposit Account No. 50/2762, referencing Attorney Docket No. W2023-7044US.

Respectfully submitted,

Date: January 13, 2012

/Allyson R. Hatton/
Allyson R. Hatton, Ph.D.
Reg. No. 54,154

LANDO & ANASTASI, LLP
One Main Street
Cambridge, Massachusetts 02142
United States of America
Telephone: 617-395-7000
Facsimile: 617-395-7070